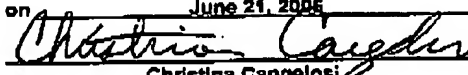


**THE UNITED STATES PATENT AND TRADEMARK OFFICE  
TRANSMITTAL LETTER****RECEIVED  
CENTRAL FAX CENTER****In re Application of:**  
**KARIN BERGSTROM, et al.****Docket No.: PST6148US1/2159****JUN 21 2005****Serial No: 10/642,882****Group Art Unit: 1621****Filing Date: August 18, 2003****Examiner: Rosalynd Ann Keys****Title: AN ORTHO ESTER-BASED  
SURFACTANT, ITS PREPARATION AND USE :****CERTIFICATE OF FACSIMILE TRANSMISSION**  
It is hereby certified that the attached: Response to  
Office Action; ( 8 sheets) is being faxed to  
703-872-8306 to the Commissioner for Patents**Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450**on June 21, 2005  
  
Christina Cangelosi**Sir:****Transmitted herewith is a responsive document(s) for this application.****☒ TRANSMITTAL LETTER IN DUPLICATE; PETITION TO THE COMMISSIONER AND  
CERTIFICATE OF FACSIMILE**

- ☐ Applicant hereby petitions for an extension of time under 37 CFR 1.136 of:
- |   |  |
|---|--|
| <input type="checkbox"/> One Month (\$120.00)     | <input type="checkbox"/> Two Months (\$ 450.00)  |
| <input type="checkbox"/> Three Months (\$1020.00) | <input type="checkbox"/> Four Months (\$1590.00) |

**☒ Petition Fee (\$400.00) under 37 CFR 1.17(f) (Group I)**

The total fee believed due is \$ 400.00 . Please charge this amount and any other fees, which may be due (including filing fees under 37 CFR 1.16 and processing fees under 37 CFR 1.17) to Deposit Account No. 01-1350. If an extension of time is required but has not been requested above, Applicant hereby petitions for an extension of time sufficient for the attached document(s) to be timely. A duplicate copy of this sheet is enclosed.

**Respectfully submitted,****Ralph J. Mancini  
Attorney for Applicant(s)  
Reg. No. 34,054****RECEIVED  
OIPE/IAP****Akzo Nobel Inc.  
Intellectual Property Department  
7 Livingstone Avenue  
Dobbs Ferry, NY 10522-3408  
Tel No.: (914) 674-5465****JUN 22 2005**

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CENTRAL FAX CENTER

JUN 21 2005

**PATENT**  
**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**In re Application of:  
KARIN BERGSTROM, et al.

Serial No: 10/642,882

Filing Date: August 18, 2003

Title: AN ORTHO ESTER-BASED  
SURFACTANT, ITS PREPARATION AND USE :Mail Stop Petition  
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Alexandria, VA 22313-1450

Docket No.: PST6148US1/2159

Group Art Unit: 1621

Examiner: Rosalynd Ann Keys

**CERTIFICATE OF FACSIMILE TRANSMISSION**  
It is hereby certified that the attached: Response to  
Office Action; ( 8 sheets) is being faxed to  
703-872-9306 to the Commissioner for Patents

on June 21, 2005

  
Christina Cangelosi

06/22/2005 SFELEKE1 00000082 011350 10642882

01 FC:1464

130.00 DA

Petition to the Commissioner

Sir:

In accordance with the provisions of 37 CFR §1.181, applicants respectfully petition and request invocation of the supervisory authority the Commissioner of Patents over the examiner's refusal to enter an amendment under 37 C.F.R. 1.111 filed on April 26, 2005. More specifically, the Honorable Commissioner is respectfully requested to overrule the examiner's decision and direct that the Amendment filed on April 26, 2005 and second Declaration Under 1.132 attached thereto be entered for consideration on the merits.

Fact Summary

1. On November 16, 2004 applicants filed an Amendment in response to the Official Action mailed on June 17, 2004. The claims were **not amended**, which was clearly indicated on page 1 of the Amendment. Applicants did, however, reproduce the claims for the convenience of the examiner. Unfortunately, there was a **typographical error that appeared in both claims 1 and 16** of the reproduced claims, i.e., instead of

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Void date: 06/22/2005 SFELEKE1  
06/22/2005 SFELEKE1 00000044 011350 10642882  
01 FC:1462 400.00 DA

bonds between the respective oxygen atoms and the carbon atom in the formula (I), a "question mark" (?) appeared.

2. On January 26, 2005, the examiner mailed out a "final" action concerning the above case. In that action and in response to applicants' arguments the examiner set forth new grounds for rejecting applicants' claims. Those new grounds for rejection are reproduced below for the convenience of the Honorable Commissioner:

"The Applicants' arguments and showing are sufficient to overcome the rejection with respect to the compounds having the claimed formula (I), when  $n_2$  is at least 1. However, when  $n_2$  is 0 the claims are still considered to be obvious over Askew et al. and Elliott et al. because the showing did not include compounds wherein  $n_2$  is zero. Thus, the showing is not commensurate in scope with the protection sought."

(Page 5, paragraph No. 12, of the final action, emphasis ours.)

4. Additionally, on page 3, paragraph No. 7 of the final action, the examiner also rejected applicants' claims under 35 U.S.C. § 112, second paragraph.

"Claims 1-4, 6-8, 13, 14 and 16 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter which applicant regards as the invention."

However, the examiner failed to indicate basis for the 112 rejection, essentially leaving applicants guessing as to the nature of same.

6. On April 26, 2005, applicants filed a response to the final action. In applicants' response, the claims were again **NOT** amended, which is clearly indicated on the first page of the response. Applicants' did, however, again reproduce a copy of the claims for the convenience of the examiner, and the **typographical errors** that appeared in applicants' prior Amendment filed November 16, 2004 were corrected.

6. On page 6, fourth full paragraph of said response, applicants requested clarification as to the nature of the 35 U.S.C. § 112, second paragraph rejection. This clearly shows that applicants were confused as to the nature of this rejection.

7. Finally, attached to applicants April 26, 2005 response was a second Declaration Under 35 U.S.C. § 1.132, which was specifically directed to the new grounds of rejection relied on by the examiner to reject applicants' claims (see paragraph No. 2, above). In the second Declaration applicants tested compounds where the hydrophobic substituent is only an alkyl group without any propyleneoxy units, i.e., where  $n_2$  is zero, thereby directly addressing the new grounds raised by the examiner (See paragraph No. 2, above.) Applicants respectfully submit that the data presented in the Second Declaration clearly demonstrate the surface tension and wetting capabilities of the compounds according to the claimed invention where  $n_2$  is 0. Additionally, the data clearly addressed and overcame the only remaining issue identified by the examiner and supports the conclusion that the compounds of the present invention are unexpectedly superior surfactants compared to the compounds of Askew et al.

8. On May 19, 2005 the examiner issued an Advisory Action holding that applicants' declaration under 37 C.F.R. 1.132 was untimely. A copy of that Advisory Action is attached hereto as Exhibit 4.

9. On May 25<sup>th</sup>, 2005 applicants had a telephone conference with the examiner. In the conference applicants indicated that the second Declaration was, in fact timely in that it responded directly to the new ground of rejection relied on by the examiner. In support of applicants' position, applicants cited and relied on MPEP 716.01 (A)(3)(i) which states, in pertinent part, that:

Affidavits and declarations submitted under 37 CFR 1.132 and other evidence traversing rejections are considered timely if submitted:

- (1) prior to final rejection,
- (2) before appeal in an application not having a final rejection, or
- (3) after final rejection and submitted

(i) with a first reply after final rejection for the purpose of overcoming a new ground of rejection or requirement made in the final rejection, or...

In the present situation, the examiner clearly instituted a new ground of rejection in the final action and applicants went through **great time and expense to generate a second Declaration in order to overcome said new grounds of rejection.** According to MPEP716.01 (A)(3)(i), applicants' response of April 26, 2005 and the second Declaration attached thereto was clearly filed in a timely fashion and should have been considered on the merits.

10. Despite the prevailing authority that supports applicants' position, the examiner refused to enter applicants' amendment and second Declaration filed April 26, 2005. The examiner's position is documented in the Interview Summary mailed out on June 1, 2005. In the Interview Summary, the examiner now alleges that:

"the new ground of rejection was under 35 USC 112, second paragraph (a ? appears between the C and O atoms rather than a bond) and that the final rejection under 35 USC 103(a), mailed 1/26/05, is based upon the same grounds as the non-final rejection under 35 USC 103(a) mailed 6/17/04. Thus, the Declaration is untimely because it was not filed for the purposes of overcoming a new ground of rejection or requirement made in the final rejection."

11. Applicants obviously disagree with the examiner basis for refusing entry of the response in question. More specifically, the Honorable Commissioner is respectfully requested to note that:

- a) The claims were **not amended** in the response mailed on June 17, 2004; a **typographical error** appeared in the reproduced claims;
- b) This typographical error was **corrected** in the response mailed April 26, 2005 (obviously then it was filed for purposes of overcoming the 112 rejection in addition to overcoming the new grounds for rejection). **Therefore, assuming that the § 112 rejection was properly instituted in the first place, it was clearly rendered MOOT by applicants' response of April 26, 2005;**

- c) The final rejection under 35 USC 103(a), mailed 1/26/05, is clearly **NOT** based upon the same grounds as the non-final rejection under 35 USC 103(a) mailed 6/17/04. In this regard it is clear that the new grounds for rejection repeated in paragraph No. 2, above, are not found in the Office Action mailed 6/17/04;
- d) Applicants' response of April 26, 2005 and the second Declaration under 1.132 attached thereto specifically directed to the aforementioned new grounds for rejection. This second Declaration is believed to overcome the examiner's new grounds for rejection, thereby placing the present case in condition for allowance.

Accordingly, by correcting the typographical errors that appeared in claims 1 and 16, the 112 rejection was rendered moot (assuming that it was proper to institute in the first place. Additionally, the second Declaration submitted by applicants was specifically directed to the **new grounds of rejection relied on by the examiner**. Therefore, applicants respectfully submit that, according to MPEP716.01 (A)(3)(i), the response of April 26, 2005 and the second Declaration attached thereto were timely filed and should have been entered for consideration on the merits. Unfortunately, despite applicants' best efforts to convince the examiner that there was no basis for refusing entry of applicants' April 26, 2005 response, the examiner refused entry thereof, which necessitated the filing of the present petition.

### **Conclusions**

Applicants respectfully submit that the response of April 26, 2005 and the second Declaration attached thereto were specifically directed to the new grounds of rejection relied on by the examiner to reject applicants' claims. The aforementioned response also rendered the section 112 rejection moot. According to MPEP716.01 (A)(3)(i) applicants response of April 26, 2005 was timely filed and should have been entered for consideration on the merits. The Honorable Commissioner is therefore respectfully requested to reverse the examiner refusal to enter applicants response of

April 26, 2005 and direct the examiner to enter same for expedited consideration on the merits.

Respectfully submitted,



Ralph J. Mancini  
Attorney for Applicants  
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